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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,599	06/29/2001	Marcos Nogueira Novaes	YOR920010318US1	6500

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EXAMINER

SIDDIQI, MOHAMMAD A

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/893,599

Applicant(s)

NOVAES, MARCOS NOGUEIRA

Examiner

Mohammad A. Siddiqi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-8,23-33 and 36 is/are pending in the application.
- 4a) Of the above claim(s) 1,3-5,9-22,34,35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-8,23-33 and 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 02/28/2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 6-8, 23-33, and 36 are presented for the examination. Claims 1, 3-5, 9-22, 34, and 35 have been withdrawn from further consideration. Claim 2 has been cancelled.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/10/2005 has been entered.

3. Claims 1, 3-5, 9-22, 34, and 35 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 06/10/2005.

Claim Rejections - 35 USC § 101

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claim 36 rejected under 35 U.S.C. 101 because 35 U.S.C. 101 reads as follows:

Claim 36 is not limited to tangible embodiments. In view of Applicant's disclosure, specification page 42, the medium is not limited to tangible embodiments. As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 6-8, 23-33, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Egger et al. (6,233,571) (hereinafter Egger) in view of Anupam et al. (5,991,796) (hereinafter Anupam).

7. As per claims 6, 23, and 36, Egger discloses a Web-based collaborative research method (col 48, lines 20-45), comprising:

determining coordinates for pages (col 6, lines 6-25) which are retrieved by a first user and mapping the coordinates (col 28, lines 2-5) into a space (col 6, lines 6-50); and

based on said coordinates (col 36, lines 18-40) of said pages (col 48, lines 19-45), closeness of a research (col 5, lines 37-47, col 48, lines 63-67 and col 5, lines 38-48).

Egger is silent about informing a second user by first user.

However, Anupam discloses informing a second user by first user (fig 1, col 1, lines 46-67 and col 2, lines 1-8; col 4, lines 24-32).

Therefore it would have been obvious to one of ordinary skill in the art at the time invention was made to combine Anupam with Egger because it would provide user friendly computerized, web enabled, and an intelligent research tool that emulates human methods of research.

8. As per claims 7 and 24, claims are rejected for the same reasons as

claims 6 and 23, above. In addition, Anupam discloses informing is performed automatically by a server, said first and second users being informed of pages retrieved by one another (fig 1, col 2, lines 25-67).

9. As per claims 8 and 25, claims are rejected for the same reasons as claims 6 and 23, above. In addition, Egger discloses wherein an intersection of research by said first and second users is graphically displayed to said first and second users (col 5, lines 37-48).

10. AS per claim 26, the claim is rejected for the same reasons as claim 23, above. In addition, Egger discloses a unit providing the first user with a trail of research of said second user (col 35, lines 25-36).

11. As per claim 27, Egger discloses trail of research comprises a predetermined sequence of bookmarks leading said first user to a specific point in cyberspace (col 48, lines 46-48).

12. As per claim 28, the claim is rejected for the same reasons as claim 23, above. In addition, Egger discloses a log-unit (fig 4B element 260) for enabling said user to log-in to a collaborative research portal (col 48, lines 19-26); a selector for selecting an existing research session (col 48, lines

63-67 and col 49 lines 1-11), or creating a new research session (col 49, lines 12-36).

13. As per claim 29, the claim is rejected for the same reasons as claim 23, above. In addition, Egger a retrieval unit for retrieving a first data block (fig 4B, col 24, lines 49-51; col 48, lines 39-42);

a receiving unit for receiving data blocks of other users having a predetermined closeness (col 4B, lines 23-67), and an index of other data blocks relevant to the user's research (col 4B, lines 23-67).

14. As per claim 30, the claim is rejected for the same reasons as claim 23, above. In addition, Egger discloses on a transmission unit for sending to the user a list of previously created research session (elements of Fig 4B; col 23-67); and after the retrieving by the user (fig 4B, col 23-67), an adder for adding spatial coordinates of the first data block to a collection of vertices to a current research session (col 6, lines 6-25).

15. As per claim 31, the claim is rejected for the same reasons as claim 23, above. In addition, Egger discloses a calculator for recalculating areas occupied by the vertices of the current research session (col 6, lines 6-25); and for calculating an intersection of the current research session with

research sessions created by other users (col 6, lines 6-25).

16. As per claim 32, the claim is rejected for the same reasons as claim 23, above. In addition, Egger discloses a determining unit for determining whether any research sessions intersect (col 6, lines 6-25); and a notifier for notifying, if any research sessions intersect (col 6, lines 6-25), users that created the intersecting sessions (col 6, lines 6-67).

17. As per claim 33, the claim is rejected for the same reasons as claim 23, above. In addition, Egger discloses means for sending unit for sending the users of the intersecting sessions a geometry of the other intersecting sessions (col 6, lines 6-67).

Response to Arguments

18. Applicant's arguments filed 12/06/2004 have been fully considered but they are not persuasive, therefore rejections to claims 6-8, 23-33, and 36 is maintained.

19. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks

the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

20. The Examiner takes note the above Applicant's remark; however, Applicant's remark could not be imported into the claim. Therefore, the Examiner could not consider Applicant's remark.

21. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case:

Egger teaches determining coordinates for pages (algorithm is used to determine coordinates, col 6, lines 15-25) which are retrieved by a first user and mapping the coordinates into a space (col 6, lines 6-50); and based on said coordinates (col 36, lines 18-40) of said pages (col 48, lines 19-45), closeness of a research (col 7, lines 54-67, col 48, lines 63-67 and col 5,

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lines 38-48). Anupam discloses informing a second user by first user (surrogate, 153,173, fig 1, col 1, lines 66-67 and col 2, lines 1-8). Therefore it would have been obvious to one of ordinary skill in the art at the time invention was made to combine the teaching Egger with Anupam because Anupam's use of creating surrogate for the user and inter surrogate communication would provide Egger's system user friendly computerized, web enabled, and an intelligent research tool that emulates human methods of research.

Conclusion

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad A. Siddiqi whose telephone number is (571) 272-3976. The examiner can normally be reached on Monday -Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A. Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MAS

LARRY D. DONAGHUE
PRIMARY EXAMINER

